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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/089,223 '	. 09/17/2002	Kai Fabian	MERCK 2408	2485	
23599 759 MILLEN, WHITI	90 12/19/200 E, ZELANO & BRA	=	EXAMINER		
2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			PRICE, ELVIS O		
			ART UNIT	PAPER NUMBER	
			1621		
SHORTENED STATUTORY P	PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
· 3 MONT	THS	12/19/2006	PAF	ER	

# Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)				
Office Action Communication	10/089,223	FABIAN ET AL.				
Office Action Summary	Examiner	Art Unit				
	Elvis O. Price	1621				
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with t	he correspondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICAT 36(a). In no event, however, may a reply vill apply and will expire SIX (6) MONTHS cause the application to become ABAND	TION.  be timely filed  from the mailing date of this communication.  ONED (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 29 Ju	ıne 2005.					
·_ ·	action is non-final.					
3) Since this application is in condition for allowar		prosecution as to the merits is				
closed in accordance with the practice under E	•	•				
Disposition of Claims						
4)⊠ Claim(s) <u>1-19</u> is/are pending in the application.						
4a) Of the above claim(s) <u>16-19</u> is/are withdraw						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1-3,6 and 8-15</u> is/are rejected.						
7)⊠ Claim(s) <u>4,5 and 7</u> is/are objected to.						
8) Claim(s) are subject to restriction and/or	r election requirement.					
Application Papers						
9) The specification is objected to by the Examine	r.					
10) The drawing(s) filed on is/are: a) acce		he Examiner.				
Applicant may not request that any objection to the	drawing(s) be held in abeyance.	See 37 CFR 1.85(a).				
Replacement drawing sheet(s) including the correcti	ion is required if the drawing(s) is	s objected to. See 37 CFR 1.121(d).				
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Of	fice Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
12)⊠ Acknowledgment is made of a claim for foreign a)⊠ All b)□ Some * c)□ None of:		9(a)-(d) or (f).				
1. Certified copies of the priority documents						
2. Certified copies of the priority documents						
3. Copies of the certified copies of the prior	•	eived in this National Stage				
application from the International Bureau	,	a live and				
* See the attached detailed Office action for a list of	or the certified copies not rec	eivea.				
Attachment(s)	<b></b> .					
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) ∐ Interview Sumr Paper No(s)/Ma	nary (PTO-413) ail Date				
3) X Information Disclosure Statement(s) (PTO/SB/08)	5) 🔲 Notice of Inform					
Paper No(s)/Mail Date <u>2/4/03</u> .	6)  Other:					

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#### **DETAILED ACTION**

1. Claims 1-19 are pending in the application.

2. Applicant's election with traverse of Group I (claims 1-15) in the reply filed on 6/29/05 is acknowledged. The traversal is on the ground(s) that the Examiner did not establish that it would be burdensome to search all inventions. This is not found persuasive because prior art anticipating or rendering the invention of Group I obvious would not necessarily anticipate or render obvious the invention of Group II. Thus, it would be burdensome to search and prosecute the two distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 6, 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bitner et al. {Lipids, Vol. 5(8), 1970, pp. 707-712}.

Bitner et al. disclose the instantly claimed process for the bromination of an organic compound using a microreactor (see Halogenation reaction on page 710).

#### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 8, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bitner et al. {Lipids, Vol. 5(8), 1970, pp. 707-712}.

Bitner et al. disclose the instantly claimed process for the bromination of an organic compound using a microreactor (see Halogenation reaction on page 710).

Although Bitner et al. does not teach the reaction flow rate, how the brominated product is isolated and whether a catalyst could be used in the reaction, as recited in the above claims, it would not be unreasonable for one having ordinary skill in the art vary the reaction flow rate or the amount of any catalyst to obtain the optimum results. Additionally, the Examiner takes official notice that the isolation of an organic product via extraction or precipitation are standard procedures in the art and would not amount to any patentable distinction, absent any unexpected results. Also, the Examiner takes official notice that it is well known in the art that Lewis acids, such as metal halides, can affectively be used as catalysts in bromination reactions.

Thus, it would have been obvious, in vie of the teaching of the Bitner et al.

reference and what was already know in the art, for one having ordinary skill to arrive at

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the presently claimed invention. One having ordinary skill in the art, desiring to arrive at alternative methods and/or optimum parameters for brominating organic compounds, would have been motivated to use bromination catalysts and/or manipulate reaction conditions, respectively, in an effort to do so. Therefore, the instantly claimed invention would have been obvious to one having ordinary skill in the art.

### Allowable Subject Matter

Claims 4, 5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 571 272-0644. The examiner can normally be reached on 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elvis O. Price